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09/851,923	05/09/2001	Julian S. Taylor	SMQ-117/P6141	3713

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EXAMINER

NAHAR, QAMRUN

ART UNIT PAPER NUMBER

2124

DATE MAILED: 05/12/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/851,923

Applicant(s)

TAYLOR, JULIAN S.

Examiner

Qamrun Nahar

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-58 have been examined.

Information Disclosure Statement

2. The information disclosure statement (IDS) filed on 3/5/02 has been considered by the examiner.

Specification

3. The abstract of the disclosure is objected to because "At least one patch includes content to add the computer" on line 7 of page 33 of the specification should be "At least one patch includes content to add **to** the computer". Correction is required. See MPEP § 608.01(b).

4. The disclosure is objected to because of the following informalities: Under the section "CROSS REFERENCE TO RELATED APPLICATIONS" on page 1 of the specification, the two related U.S. applications referred to by Attorney Docket Number should be changed to U.S. Serial Numbers and indicate status of the two related U.S. applications.

Appropriate correction is required.

5. The disclosure is objected to because of the following informalities: "At least one patch includes content to add the computer" on line 25 of page 2 of the specification should be "At least one patch includes content to add **to** the computer".

Appropriate correction is required.

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6. The disclosure is objected to because of the following informalities: “Microsoft**” and “Setup Factory**” on lines 3 and 4, respectively, of page 2 of the specification are unclear. They appear to indicate footnotes, however, no footnote was found on page 2. Only one footnote was found on page 17, but it does not relate to “Microsoft**” and “Setup Factory**”.

Appropriate correction is required.

Claim Objections

7. Claim 15 is objected to because of the following informalities: “to determined” on lines 3-4 of the claim should be “to determine”. Appropriate correction is required.

8. Claim 31 is objected to because of the following informalities: claim 31 depends on claim 32. Claim 31 is interpreted as depending on claim 30. Appropriate correction is required.

9. Claim 33 is objected to because of the following informalities: “to determined” on lines 3-4 of the claim should be “to determine”. Appropriate correction is required.

10. Claim 51 is objected to because of the following informalities: “to determined” on lines 3-4 of the claim should be “to determine”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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12. Claims 9, 13, 27, 31, 45, 49 and 58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. Claim 9 recites the limitation "the realization routine" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim. This limitation is interpreted as "a realization routine".

14. Claim 13 recites the limitation "the code" in line 5 of the claim. There is insufficient antecedent basis for this limitation in the claim. This limitation is interpreted as "the content".

15. Claim 27 recites the limitation "the realization routine" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim. This limitation is interpreted as "a realization routine".

16. Claim 31 recites the limitation "the network administrator system" in lines 4-5 of the claim. There is insufficient antecedent basis for this limitation in the claim. This limitation is interpreted as "a network administrator system".

17. Claim 31 recites the limitation "the code" in line 5 of the claim. There is insufficient antecedent basis for this limitation in the claim. This limitation is interpreted as "the content".

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18. Claim 45 recites the limitation "the realization routine" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim. This limitation is interpreted as "a realization routine".

19. Claim 49 recites the limitation "the code" in line 5 of the claim. There is insufficient antecedent basis for this limitation in the claim. This limitation is interpreted as "the content".

20. Claim 58 recites the limitation "the network administrator system" in lines 7-8 of the claim. There is insufficient antecedent basis for this limitation in the claim. This limitation is interpreted as "a network administrator system".

Double Patenting

21. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438; 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

22. Claims 1-58 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-52 of copending

Application No. 09/852113 in view of Bartoletti et al., "Secure Software Distribution System",

1997 (hereinafter "Bartoletti"). The following example is given in which the actual claim language of Application No. '113 is given for clarity.

As per claim 1 of the instant application, '113 discloses (in claim 1):

A method for determining patches to apply to a computer system, wherein the patches includes content to add to the computer, comprising:

providing a realization list of realization identifiers corresponding to realizations associated with the computer, wherein each realization defines a state of the computer;

providing a *realization database* of realization objects, wherein each realization object is uniquely identified by a realization identifier of one realization and includes a patch list indicating those patches whose installation relates to the computer state defined by the realization;

accessing from the *realization database* the patch lists of those realization objects whose realization identifiers match the realizations identifiers on the realization list;

determining all the patches on the accessed patch lists; and

determining from the determined patches on the accessed patch lists those patches that are capable of being installed on the computer.

The instant application does not claim providing a *realization database* of realization objects, wherein each realization object is uniquely identified by a realization identifier of one realization and includes a patch list indicating those patches whose installation relates to the computer state defined by the realization or accessing from the *realization database* the patch lists of those realization objects whose realization identifiers match the realizations identifiers on the realization list.

Bartoletti teaches providing a *realization database* of realization objects, wherein each realization object is uniquely identified by a realization identifier of one realization and includes a patch list indicating those patches whose installation relates to the computer state defined by the realization and accessing from the *realization database* the patch lists of those realization objects whose realization identifiers match the realizations identifiers on the realization list (pg. 5, par. 1, lines 5-17 to pg. 6, lines 1-4).

Therefore, it would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the claimed method of the instant application to include providing a *realization database* of realization objects, wherein each realization object is uniquely identified by a realization identifier of one realization and includes a patch list indicating those patches whose installation relates to the computer state defined by the realization and accessing from the *realization database* the patch lists of those realization objects whose realization identifiers match the realizations identifiers on the realization list using the teaching of Bartoletti. The modification would be obvious because one of ordinary skill in the art would be motivated to maintain copies of all patches and all patch revisions.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

23. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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24. Claims 1-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Bartoletti et al., "Secure Software Distribution System", 1997 (hereinafter "Bartoletti").

Per Claim 1:

The Bartoletti publication discloses:

- **a method for applying a patch to a computer system, wherein the patch includes content to add to the computer** ("The Secure Software Distribution System (SSDS) will provide automated analysis, notification, distribution, and installation of security patches and related software to network-based computer systems in a vendor-independent fashion. SSDS will assist with the authentication of software by comparing the system's objects with the patch's objects." SSDS will monitor vendors' patch sites to determine when new patches are released and will upgrade system software on target systems automatically." in pg. 1, abstract, lines 2-7)
- **determining at least one of installed hardware and software components on the computer; generating a computer object including configuration information on the determined installed components; providing at least one patch including content to add to the computer, wherein each patch is capable of being associated with at least one realization, wherein each realization defines a state of the computer; for each realization, determining from the configuration information in the computer object whether the state defined by the realization exists in the computer; writing data to the computer object indicating whether the state defined by the realization exists on the computer; and using the computer object**

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to determine whether each patch is compatible with the installed components of the computer (“To evaluate a system, the SSDS Server asks the SSDS Agent running on the target system what operating system, version, and architecture is running on the target. It then collects all of the patches from the patch spec database pertaining to this system’s operating system, version, and architecture. From these patch specifications a list of directories and files manipulated by the patch specifications is formed. The owner, access control list, and checksum (for files only) for each file or directory on the list is checked against the owner, access control list, and checksums of the respective directory or file on the target system. This check permits the SSDS Server to determine which patches are actually installed on the target system without relying on the system’s local database. From this information, the SSDS Server can determine which patches need to be installed on the target system in order to bring it up-to-date.” in pg. 6, par. 2, lines 6-17).

Per Claim 2:

The Bartoletti publication discloses:

- wherein the patch content to add to the computer is capable of comprising one of: a new program; an upgrade to an installed program; a fix to an installed program; and documentation (pg. 4, par. 4, lines 1-7).

Per Claim 3:

The Bartoletti publication discloses:

- wherein one realization is capable of being dependent on another realization in the computer object further comprising: determining whether the realization is dependent on at least one base realization; and if the realization is dependent on at least one base realization, performing: (i) determining whether the computer object includes information on the base realizations; and (ii) if the computer object does not include information on the base realizations, then throwing an exception (pg. 5, par. 1, lines 10-17 to pg. 6, par. 1, lines 1-4).

Per Claim 4:

The Bartoletti publication discloses:

- in response to throwing the exception, preventing each patch associated with at least one realization dependent from the base realization not written to the computer object from being installed (pg. 5, par. 1, lines 10-17 to pg. 6, par. 1, lines 1-4).

Per Claim 5:

The Bartoletti publication discloses:

- wherein writing data to the computer object indicating that the state exists comprises: indicating in the computer object that the state defined by the realization exists in the computer if the state exists on the computer, and indicating in the computer object that the

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state defined by the realization does not exist computer on the computer if the state does not exist on the computer (pg. 6, par. 2, lines 6-17).

Per Claim 6:

The Bartoletti publication discloses:

- wherein determining from the computer object whether the state exists on the computer includes determining whether information on one previously considered realization is written to the computer object (pg. 6, par. 2, lines 6-17).

Per Claim 7:

The Bartoletti publication discloses:

- wherein each patch is further associated with a patch expression that is capable of processing the computer object to determine whether to add the content from the patch onto the computer (pg. 4, par. 4, lines 1-7 and pg. 5, par. 1, lines 10-15).

Per Claim 8:

The Bartoletti publication discloses:

- further comprising downloading one or more realization detectors, wherein each realization detector is used to check at least one realization, and wherein each realization

detector includes detector code to determine whether states defined by realizations exist on the computer and to write data to the computer object concerning the existence of the determined states (pg. 5, par. 1, lines 10-17 to pg. 6, par. 1, lines 1-4).

Per Claim 9 (as best understood):

The Bartoletti publication discloses:

- downloading a plurality of patches to the computer, each including content to add to the computer, wherein the steps of executing a realization routine, writing data to the computer object, and using the computer object to determine whether the patch is compatible with the installed components of the computer is performed on the computer (pg. 6, par. 2, lines 6-17).

Per Claim 10:

The Bartoletti publication discloses:

- generating a list of all patches determined to be compatible with the installed components of the computer; and rendering the list of patches on an output device to enable a user to select the content of one or more of the patches on the list to add to the computer (pg. 6, par. 2, lines 17-21).

Per Claim 11:

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The Bartoletti publication discloses:

- maintaining, at a network administrator system, a plurality of computer objects associated with a plurality of computers on a network, wherein each computer object includes the configuration information on the determined installed components of one computer on the network, and wherein the steps of determining whether the state defined by the realization exists on the computer, writing data to the computer object, and using the computer object to determine whether the patch is compatible with the installed components of the computer on the network is performed for computer objects on the network administrator system (pg. 5, par. 1, lines 10-17 to pg. 6, par. 1, lines 1-4).

Per Claim 12:

The Bartoletti publication discloses:

- maintaining a plurality of patches at the network administrator system, wherein determining the states defined by the realizations, writing data to the computer object and using the computer objects to determine whether the patch is compatible with the installed components of the computers on the network is performed for each patch available to the network administrator system (pg. 5, par. 1, lines 10-17 to pg. 6, par. 1, lines 1-4).

Per Claim 13 (as best understood):

The Bartoletti publication discloses:

- **generating a list of all patches determined to be compatible with the installed components of the computers on the network; and rendering the list of patches on an output device to enable a user of the network administrator system to select the content of one or more of the patches on the list to install on one or more of the computers in the network** (pg. 6, par. 2, lines 17-21).

Per Claim 14:

The Bartoletti publication discloses:

- **wherein the content comprises a fix, and wherein the state defined by the realization is capable of indicating whether the computer is susceptible to a bug corrected by the fix** (pg. 4, par. 3, lines 1-10).

Per Claim 15:

The Bartoletti publication discloses:

- **wherein determining the at least one of installed hardware and software components comprises: executing a detector program on the computer to process files in the computer to determine installed hardware and software components on the computer** (pg. 6, par. 2, lines 6-8).

Per Claim 16:

The Bartoletti publication discloses:

- wherein determining the at least one of installed hardware and software components comprises: receiving user input indicating installed hardware and software components on the computer (pg. 6, par. 2, lines 8-17).

Per Claim 17:

The Bartoletti publication discloses:

- wherein the user input is received by: displaying a user interface presenting user selectable software and hardware components; and receiving user selection of software and hardware components from the displayed user interface, wherein the received user input indicating the installed hardware and software components comprises the components selected from the user interface (pg. 6, par. 2, lines 8-17).

Per Claim 18:

The Bartoletti publication discloses:

- wherein reading and writing performed as part of adding content to the computer is restricted to the computer object on the computer (pg. 6, par. 2, lines 6-17).

Per Claims 19-36:

These are system versions of the claimed method discussed above (claims 1-18, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Bartoletti.

Per Claims 37-54:

These are article of manufacture versions of the claimed method discussed above (claims 1-18, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Bartoletti.

Per Claims 55-58:

These are computer readable medium versions of the claimed method discussed above (claims 1, 7, 8 and 11, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Bartoletti.

Conclusion

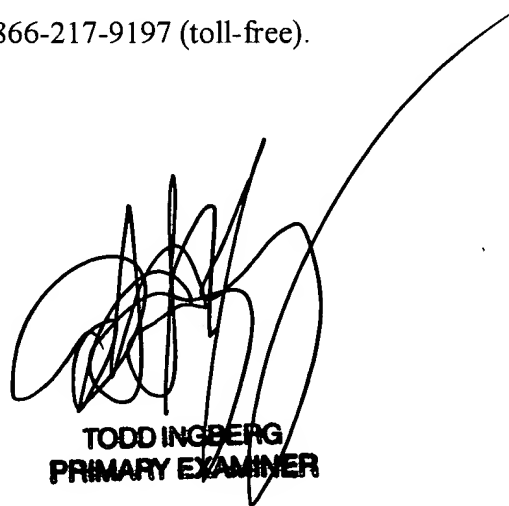
25. Any inquiry concerning this communication from the examiner should be directed to Qamrun Nahar whose telephone number is (703) 305-7699. The examiner can normally be reached on Mondays through Thursdays from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki, can be reached on (703) 305-9662. The fax phone number for the organization where this application or processing is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

QN
May 10, 2004



TODD INGBERG
PRIMARY EXAMINER